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REMARKS

It is respectfully requested that Ernst (2002/0121491) relied upon the Examiner be listed on Form PTO-892 to shown consideration thereof by the Examiner.

Claims 4-6 have been incorporated into claim 8 as previously amended. Claims 8, 9, 13, 14, 17, 19, 21 and 23 have been amended to further define the present invention in a manner to distinguish over the prior art. From a visual comparison of the present invention with the prior art, it is clear that there are differences. The Examiner basically dismisses these differences on two bases: no new or unexpected utility and matter of design choice. However, as set forth in MPEP§2144.06:

In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) ...The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another,..."

Examining the Scott decision, the CCPA held:

We disagree with the supposed logic of the Patent Office position. The Examiner and the board appear to hold that the mere existence of "functional and mechanical equivalence" establishes "obviousness". We think this involves a non-sequitur. Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. The statutory mandate of 35 U.S.C. 103 is that the claimed subject matter be unobvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. [Emphasis theirs]

Thus, even assuming that the structure of Krivec and Ernst has the same utility, for the sake of argument, does not support that the recitations of the claims (which apparently the Examiner concede do not exist) are obvious. Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as In re Newell, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth *In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

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In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

It is respectfully submitted that the prior art does not in any way support that applicant's tool-holding apparatus is within the level of ordinary skill in the art. The only suggestion of the recited construction and arrangement is the hindsight knowledge of the present invention. The Examiner has not provided any prior art evidence supporting his contention, with such evidence being indicated by the Court of Appeals for the Federal Circuit as being needed to support the present rejection. It is then respectfully submitted that the Examiner must present prior art evidence showing that the modifications that the Examiner apparently concedes are not suggested by the references applied in this official action would be a "choice" to a person skilled in the art. Furthermore, although the structure of the present invention and the prior art have utility to hold tools, it is believed that the present invention obviates or at least alleviates the problems encountered in the prior art as set forth in Background of Invention of the present application. Particularly, it is believed that the apparatus of the present invention more securely holds the spanner while allowing ease of removal when desired, is easier to manufacture, and is otherwise advantageous over the structure of the prior art.

It is then respectfully submitted that the rejection of the claims has been overcome for each of these separate and independent reasons. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as D and E of the January 5, 2005 Office communication. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's tool-holding apparatus which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 2, 3,

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8-10, 12-14 and 17-23, as amended, of the present application and to pass this application to issue.

As indicated previously, the apparatus of the present invention is clearly different from the prior art from a visual inspection. Further, a conscientious attempt has been made to define these clear differences of the present invention to distinguish over the prior art. In the event that a further rejection is made of the claims, it is respectfully requested that the Examiner initiate a telephonic interview such that any issues which obstruct the allowance of the present application can be resolved or limited.

Respectfully submitted,

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